



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/350,251 | 07/08/1999 | ARYE MALEK | 139.059US1 | 7789 |

21186 7590 04/15/2003

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

| EXAMINER |
|----------|
|----------|

NGUYEN, JOHN QUOC

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3654

30

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,251

Applicant(s)

MALEK ET AL.

Examiner

John Q. Nguyen

Art Unit

3654

-- Th MAILING DATE of this communication appears on the cov r sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 12-25 and 27-42 is/are pending in the application.
- 4a) Of the above claim(s) 22-25, 31-36 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 12-21, 27-30, 37-40 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 22,26.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant's election of the species of figs. 19A and 19B, claims 3-10, 12-21, 27-30, 37-40, and 42 in Papers No. 27 and 29 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 22-25, 31-36, and 41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Papers No. 27 and 29.

Claims 12, 20, 21, 37, 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed (claims 12, 20, 21).

For clarity and/or definiteness, it appears that "of a" (claim 37, line 4) should be --of said--.

All claims should be revised carefully to correct all other deficiencies similar to the ones noted above. The non-elected claims should also be similarly corrected at the same time so that the application can be allowed without delay should the generic claims become allowable.

Claims 3-10, 12-21, and 27-30, 37-40, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Jackson et al (US 6139243).

The admitted prior art discussed on pages 2-5 of the specification discloses

Art Unit: 3654

substantially all the claimed features. Jackson et al discloses another similar apparatus in which the claimed inverting mechanism is disclosed. It would have been obvious to a person having ordinary skill in the art to provide the admitted prior art apparatus with an inverting mechanism as taught by Jackson et al to invert the devices. The picker and slider are old and well known in the art and the provision of such to the admitted prior art apparatus would have been obvious to a person having ordinary skill in the art to pick out undesirable devices and to transfer devices, respectively. It should be noted that the tray is deemed an intended use object in the machine-vision system and that statements of intended use carry little patentable weight; in other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. On the other hand, the type/size of the tray and the direction of movement of the tray would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as preference, design criteria, space optimization. Relative to claim 39, the number of inspection stations is deemed inherent in the admitted prior art or, alternatively, would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as design criteria.

Applicant's arguments filed 6/19/02 have been fully considered but they are not persuasive.

As noted above, it is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed. The distance between the two inspection station cannot be shorter simply because the tray is shorter. If this were true, a person can therefore reduce the distance of travel between two cities by traveling in a shorter car.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

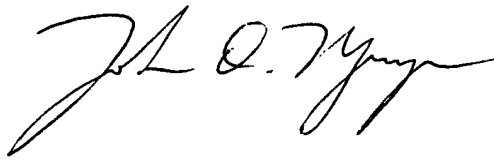
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Q. Nguyen whose telephone number is (703) 308-2689. The examiner can normally be reached on Monday-Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Matecki, can be reached on (703) 308-2688. The fax phone

Art Unit: 3654

numbers for the organization where this application or proceeding is assigned are (703) 872-9326 (before Final) and (703) 872-9327 (after Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.

A handwritten signature in black ink, appearing to read "John Q. Nguyen". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

John Q. Nguyen
Primary Examiner
Art Unit 3654